

Appl. No. 10/535,436
Docket No. Z-7814Q_
Reply to Office Action mailed on February 28, 2011
Customer No. 27752

REMARKS

Claim Status

Claims 1, 3, 5-9 and 11-14 and 16-30 are pending in the present application. No additional claims fee is believed to be due.

Claim 15 is canceled without prejudice. Claims 2, 4, and 10 were previously canceled without prejudice.

Claims 1 and 20 have been amended to more particularly describe the injection molded part and method. Support for the amendments is found at paragraphs 2 through 6 of the published application.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC §112, Second Paragraph

The Office Action states Claim 26 is rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 26 has been amended. It is therefore submitted that claims 26 is definite and the rejection under 35 U.S.C. 112, second paragraph, has been overcome.

Claim Objections

The Office objected to claim 15. Claim 15 has been canceled. As such, this objection is moot.

Rejection Under 35 USC §102(b) Over Nishihira et al.

Claims 1, 3, 5-9, 11-14, 16-17, 19-27, 29 and 30 are rejected as being anticipated by Nishihira et al. (4,330,578).

However, as will be set forth in detail below, it is believed that the injection molded part defined by claim 1 and the method defined by claim 20 are not anticipated by

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Nishihira. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

Nishihira does not teach an injection molded part having a body injection-molded from a first plastic and a decorative visible side of a decoration applied to the surface of the body such that the decorative visible side is protected from damage during a subsequent injection-molded encapsulation of a second plastic covering the decoration as required by claims 1 and 20. Rather, Nishihira discloses forming a molded piece 11 by injection molding, forming a printed ink layer 3 on the surface 11a and then curing. According to the specification of Nishihira, use of a thermoplastic resin or too thick of a layer of a thermosetting ink will result in the printed pattern being deformed by the melt flow of the resin during the subsequent injection molding. (See col. 2, lines 43-66). Thus, the ink layer of Nishihira is applied such that the rear side of the printed surface is applied to the molded piece 11. This is an important difference because by the arrangement as required by claims 1 and 20, the visible side of the decoration is covered by the basic body during the encapsulation, and is consequently protected from damage. In addition, as a result, the rear side is much less sensitive and any damage caused to the rear side by the injection pressure and thermal loading has largely no influence on the visible side of the decoration.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Because Nishihira fails to teach every element of independent claims 1 and 20, Applicants assert that independent claims 1 and 20 are in condition for allowance. Further, because claims 3, 5-9, 11-14 and 16-19 depend directly or indirectly from claim 1 and claims 21-27 and 29-30 depend directly or indirectly from claim 20, they too are not anticipated by Nishihira and therefore, are in condition for allowance.

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Rejection Under 35 USC §103(a) Over Nishihira

Claims 18 and 28 have been rejected under 35 USC §103(a) as being unpatentable over Nishihira et al. This rejection is respectfully traversed by Applicants since Nishihira does not establish a *prima facie* case of obviousness because it does not teach or suggest all of the claim limitations of independent claims 1 and 20. Therefore, the rejection should be withdrawn.

In order for the Office to show a *prima facie* conclusion of obviousness, M.P.E.P. §2142 requires a clear articulation of the reasons why the claimed invention would have been obvious. Specifically, the Supreme Court in *KSR International Co. v. Teleflex Inc.*, 500 U.S. 398, 82 USPQ2d 1385, 1396 (2007) noted that the burden lies initially with the Office to provide an explicit analysis supporting a rejection under 35 U.S.C. 103. “[R]ejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” The Court in *KSR International* further identified a number of rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in *Graham v. John Deere Co.* 383 U.S. 1, 148 USPQ 459 (1966).

Specifically, as previously required by the TSM (teaching, suggestion, motivation) approach to obviousness, one exemplary rationale indicated requires teaching, suggestion, or motivation in the prior art reference that would have led one of ordinary skill to modify the prior art reference to arrive at the claimed invention. Specifically, to reject a claim based on this rationale, the Office must articulate the following: (1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings to arrive at each and every limitation of the claimed invention; (2) a finding that there was a reasonable expectation of success; and (3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness. The Office has failed to meet its burden under number (1) above, as the cited reference fails to show each and every limitation of Applicants’ invention and there

is no apparent reason for one skilled in the art to modify the reference to arrive at each and every limitation. It simply would not have been obvious to one skilled in the art to arrive at Applicants' claimed combinations.

As detailed above, Nishihira does not teach an injection molded part having a body injection-molded from a first plastic and a decorative visible side of a decoration applied to the surface of the body such that the decorative visible side is protected from damage during a subsequent injection-molded encapsulation of a second plastic covering the decoration as required by claims 1 and 20. Rather, Nishihira discloses forming a molded piece 11 by injection molding, forming a printed ink layer 3 on the surface 11a and then curing. According to the specification of Nishihira, use of a thermoplastic resin or too thick of a layer of a thermosetting ink will result in the printed pattern being deformed by the melt flow of the resin during the subsequent injection molding. (See col. 2, lines 43-66). Thus, the ink layer of Nishihira is applied such that the rear side of the printed surface is applied to the molded piece 11. This is an important difference because by the arrangement as required by claims 1 and 20, the visible side of the decoration is covered by the basic body during the encapsulation, and is consequently protected from damage. In addition, as a result, the rear side is much less sensitive and any damage caused to the rear side by the injection pressure and thermal loading has largely no influence on the visible side of the decoration.

References relied upon to support a rejection under 35 U.S.C. 103(a) must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public. *In re Payne*, 203 U.S.P.Q. 245 (CCPA 1979). Because the cited references fail to teach all of the claim limitations of independent claims 1 and 20, the Office Action has not established a *prima facie* case of obviousness and has not placed the presently claimed article and method in the possession of the public. Since claim 18 depends directly from claim 1 and claim 28 depends directly from claim 20, the cited reference also fails to teach all of their claim limitations. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596 (Fed. Cir. 1988). Therefore, Applicants assert that claims 18 and 28 are nonobvious over the cited reference and are in condition for allowance.

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Conclusion

This response represents an earnest effort to place the present application in proper form and to distinguish the invention as claimed from the applied reference. In view of the foregoing, entry of the amendments presented herein, reconsideration of this application, and allowance of the pending claims are respectfully requested.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By /John P. Colbert/

Signature

John P. Colbert

Typed or Printed Name

Registration No. 45,675

(513) 983-6678

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